

REMARKS

Claims 1-31 were pending in this application.

Claims 1-31 have been rejected.

Claims 3, 16, 18, 25, 28 and 29 have been objected to.

Claims 1, 8, 16, 18-20, 25, 26, 29 and 31 have been amended in this Response.

Claims 3, 27 and 28 have been canceled without prejudice.

Claims 32-34 have been added

Claims 1, 2, 4-26 and 29-34 remain pending in this application.

Reconsideration of Claims 1, 2 4-26 and 29-34 is respectfully requested.

I. IN THE SPECIFICATION

The Applicants have amended the Specification to correct references to related applications. The Applicants respectfully assert that no new matter has been added and request entry of the proposed amendment.

II. IN THE CLAIMS

The Office Action objected to Claims 3, 16, 18, 25, 28 and 29 because of informalities. The Applicants have canceled Claims 3 and 28, rendering the objection moot. The Applicants have amended Claims 16, 18, 25 and 29 to correct the informalities and respectfully request withdrawal of the objection to Claims 16, 18, 25 and 29.

III. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claim 31 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,483,278 to Strubbe et al. ("*Strubbe*"). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. §102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP §2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP §2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

The *Strubbe* reference describes a system that can access information records related to downloaded electronic programs (e.g., pay-per-view movies), automatically correlate the program information with the preferences of the user, and present a personalized information database based upon the correlation. (*Abstract*). The information records relate to programming selections available to the viewer via cable, DBS, Telco, ISDN or other online program delivery service. (*Col. 3, lines 34-41*). The viewer reviews information regarding the available programming selections and registers whether he "likes" or "dislikes" the selections, as part of the process of registering his preferences. (*Fig. 4; Col. 5, lines 29-42*).

As amended, Claim 31 recites a computer user interface comprising a controller programmed to display content identifiers of media content, including at least one identifier of content not

currently, or scheduled to be, available for use. *Strubbe* lacks any mention of reviewing information relating to programming selections not currently available to the viewer. For this reason, *Strubbe* fails to anticipate the Applicants' invention as recited in Claim 31 (and its dependent claims).

Accordingly, the Applicants respectfully request withdrawal of the § 102 rejection and full allowance of Claims 1-18, 21, and 22.

IV. REJECTIONS UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1, 2, 4, 6-8, 10-12, 18 and 20-21 under 35 U.S.C. § 103(a) as being unpatentable over *Strubbe* in view of U.S. Patent No. 5,945,988 to Williams et al. ("*Williams*"). The Office Action rejects Claims 5, 9, 19 and 22-24 under 35 U.S.C. § 103(a) as being unpatentable over *Strubbe*, in view of *Williams*, in further view of U.S. Patent No. 5,798,785 to Hendricks et al. ("*Hendricks*"). The Office Action rejects Claim 25 under 35 U.S.C. § 103(a) as being unpatentable over *Strubbe*, in view of *Williams*, in further view of U.S. Patent No. 5,959,688 to Schein et al. ("*Schein*"). The Office Action rejects Claims 26 and 28 under 35 U.S.C. § 103(a) as being unpatentable over *Strubbe*, in view of *Williams*, in view of *Schein*, in further view of *Hendricks*. The Office Action rejects Claims 3 and 27 under 35 U.S.C. § 103(a) as being unpatentable over *Strubbe*, in view of *Williams*, in further view of U.S. Patent No. 5,757,282 to Girard et al. ("*Girard*"). The Office Action rejects Claims 13-17, 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over *Strubbe*, in view of *Hendricks*, in further view of *Girard*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the

reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. MPEP § 2142.

With regard to independent Claim 13, the claim recites a device comprising a controller having a program database containing identifiers of programs, including programs whose content is not currently, or scheduled to be, available for use. The controller is programmed to display a subset of those identifiers that includes at least one identifier of content that is not currently, or scheduled to be, available for use. Amended independent Claims 1, 8, 18, 25 and 29 recite comparable elements. The Office Action asserts that *Girard* teaches "program identifiers identifying programs where at least some of whose content is not currently, or scheduled to be, available for use (programming guide 40 displays past programming; col. 4, lines 9-18)." (*Office Action, paragraph beginning bottom p. 30 and ending top p. 31*). The Applicants respectfully assert that the Office Action mischaracterizes the teaching of *Girard*.

The *Girard* reference describes an interactive television system presenting an electronic program guide permitting a viewer to scroll through a list of past, current and future programs. (*Abstract*). When the viewer selects a past program, the system retrieves a stored video data stream of the selected program and transmits it to the viewer's set-top box. (*Abstract*). This allows the system to offer video on demand of past programs. (*Col. 1, lines 8-9*). The system is intended to overcome the shortcoming of conventional electronic programming guides that a viewer cannot go back and view a program that he missed, unless he remembered to record it. (*Col. 1, lines 33-36*). Thus, the purpose of the system in *Girard* is to make "past" programs available to the viewer.

As described with regard to the § 102 rejection of Claim 31, *Strubbe* lacks any mention of reviewing information relating to programming selections not currently available to the viewer. Similarly, *Hendricks* describes a set top terminal receiving program control signals corresponding to specific television programs that the subscriber may access. As such, neither *Strubbe*, *Hendricks* nor *Girard* describe a controller storing and displaying identifiers including at least one identifier of a program whose content that is not currently, or scheduled to be, available for use. Therefore, the *Strubbe*, *Hendricks* and *Girard* references, either alone or in combination, do not disclose, suggest or hint at all the claim limitations of independent Claims 1, 8, 13, 18, 25 and 29 (and claims depending therefrom). The Applicants respectfully request that the rejection of Claims 1, 2, 4-26, 29 and 30 under 35 U.S.C. § 103 be withdrawn and that Claims 1, 2, 4-26, 29 and 30 be passed to allowance.

V. NEW CLAIMS

The Applicants have added new Claims 32-34, depending from independent Claims 1, 8 and 31, respectively, and including their respective limitations. The Applicants respectfully submit that no new matter has been added and that the new claims are allowable due to their dependence from allowable base claims. The Applicants respectfully request entry and full allowance of Claims 32-34.

VI. CONCLUSION

For the reasons given above, the Applicants respectfully request reconsideration and full allowance of all pending claims and that this application be passed to issue.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: _____

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